UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,075	09/10/2003	Ryan W. Cuddy	112300-1679	6174

29159   7590   09/15/2009

K&L Gates LLP
P.O. Box 1135
CHICAGO, IL 60690

EXAMINER
MCCULLOCH JR, WILLIAM H

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
09/15/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _04 August 2009_.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-9,11-15,17-29,31-40 and 42-70_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-9,11-15,17-29,31-40 and 42-70_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _04 August 2009_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

8/4/2009 has been entered. Claims 1-9, 11-15, 17-29, 31-40, and 42-70 are pending in

the application.

Drawings

2.   A replacement drawing sheet for Figure 5 was received on 8/4/2009. The

replacement sheet is acceptable.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-9, 11-15, 17-29, 31-40, and 42-70 are rejected under 35 U.S.C. 112,

second paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention.

The claimed invention as amended now recites that the player is awarded based

upon "the determined number of locations the symbol has moved to before the symbol

moves to the first location, said award being separate from any value which is

associated with any of the locations prior to the symbol being moved to any of said

locations" (e.g., claim 1). This suggests that there are two separate classes of awards: one that is based upon the numerical value indicated on a location, and another (additional) one that is based on the overall number of locations visited.

> Applicant points to the specification as support for this embodiment which states:

> In one embodiment, the player is **not** provided any award associated with each location the player symbol is moved to, but rather the player is provided an award based on the number or amount of locations the symbol is moved to before the, game ends. In this embodiment, the greater the number of locations the player symbol is moved to during the play of the game, the greater the award provided to the player at the end of the game.

> (emphasis added, Remarks pp. 31-32)

The citation of the specification seems to suggest that providing an award based solely on the number or amount of location the symbol is moved to before the game ends is an entirely separate embodiment from the one that awards the player based on the value of each location. Therefore, the claimed invention suggests that the player might be awarded by both classes of the awards in the same invention, while the specification indicates that the two classes do not coexist in the same embodiment.

Therefore, Applicant must address the issue of whether the claimed invention seeks to employ both classes of awards in the same embodiment. For purposes of this examination, the claims will be construed to use only the class of awards that is based upon the number or amount of locations the symbol is moved to (according to the cite above). As will be described in the response to arguments below, the amendment to the claims does not show patentability over the cited prior art.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-9, 11-15, 17-29, 31-40, 42-52, 55-56, 59-60, 63-64, and 67-68 are

rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,767,283 to Weiss

(hereinafter Weiss) in view of U.S. 6,409,172 to Vancura (hereinafter Vancura).

Regarding claims 1-9, 11-15, 17-28, 51-52, 55-56, and 59-60 Weiss teaches a

gaming device and method comprising the following limitations:

- A primary game operable upon a wager by a player, including at least one

  input device configured to receive an input of a wager (see at least 3:10-67);

- A plurality of locations, which includes a first location (e.g., "Easy Street" in

  the first bonus), wherein the plurality of said locations form a path (see at

  least figs. 1 and 3-5, and descriptions thereof);

- A plurality of awards associated with a plurality of said locations along the

  path (see e.g., elements 41 in fig. 4);

- At least one symbol adapted to make a plurality of moves to a plurality of the

  locations (see e.g., element 35 in fig. 4);

- At least one setback condition associated with at least one of the locations

  along the path (see e.g., elements 43 in fig. 4);

- At least one advance condition associated with at least one of said locations along the path (see e.g., elements 41 and 46 in fig. 4);

- A display device operable to display said symbol and the locations (e.g., element 2 in figs. 2-5);

- A processor operable with the display device to control the gaming device and at least one memory device that stores a plurality of instructions executable by the processor to operate the game (e.g., processor "P" in 3:31-33, which is necessarily programmed to operate the device as described by Weiss);

- Repeating the steps of (a) causing the symbol to move to at least one location along the path toward the first location and (b) relocating the symbol to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition, until the symbol moves to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);

- Repeating the steps of (a) causing the symbol to move to at least one location along the path toward the first location, (b) providing a player any award

associated with the location of the symbol, and (c) relocating the symbol to one of the locations along the path further from the first location of the symbol moves to the location associated with the setback condition, until the symbol moves to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);

- A processor operable to provide the player at least one award based on the number of different locations the symbol is moved to (see at least 4:1-28);

- A triggering event associated with said game (see at least 3:59-67), wherein after the occurrence of said triggering event: (a) the symbol is moved to at least one location along the path toward the first location (see at least 4:1-28), (b) the symbol is relocated to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition (see at least 4:16-19), repeating steps (a) to (b) until the symbol movement terminates when the symbol is moved to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or

more times, each time having one or more moves, wherein the symbol never

lands on a "Go Home" and ultimately ends on "Easy Street", and

subsequently cashing out; see fig. 1 and descriptions thereof), and the player

is provided a total award based on any award associated with any of the

locations the symbol is moved to and the number of locations the symbol is

moved to before the symbol moves to the first location (see at least 1:65-2:14

and 4:29-58).

Regarding claims 29, 31-40, 42-50, 63-64, and 67-68, Weiss teaches a gaming

device comprising the following limitations in addition to those listed above:

- A primary game operable upon a wager by a player (see at least 3:10-67);

- A first location (see e.g., "Home" location in fig. 4);

- A second location (see e.g., "Easy Street" in fig. 4);

- A plurality of locations, wherein a designated plurality of said locations form a

  path between said first location and said second location (see at least figs. 1

  and 3-5, and descriptions thereof);

- A plurality of awards associated with a plurality of said designated locations

  along the path (see e.g., elements 41 in fig. 4);

- At least one symbol adapted to make a plurality of moves to a plurality of the

  locations (see e.g., element 35 in fig. 4);

- At least one setback condition associated with at least one designated

  location along the path (see e.g., elements 43 in fig. 4);

- At least one advance condition associated with at least one of said designated locations along the path (see e.g., elements 41 and 46 in fig. 4);

- A display device operable to display said symbol and the locations (see e.g., element 2 in figs. 2-5);

- A processor operable with the display device to control the gaming device and at least one memory device that stores a plurality of instructions executable by the processor to operate the game (e.g., processor "P" in 3:31-33, which is necessarily programmed to operate the device as described by Weiss);

- Repeating the steps of (a) causing the symbol to move to different designated locations along the path from the first location toward the second location and (b) relocating the symbol to one of the designated locations along the path toward the first location and further from the second location if the symbol moves to the designated location associated with the setback condition, until the symbol moves to one of the locations that is not between the first location and the second location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);

- Repeating the steps of (a) causing the symbol to move to different designated locations along the path from the first location toward the second location, (b) providing the player any award associated with the location of the symbol, (c) relocating the symbol to one of the designated locations along the path toward the first location and further from the second location if the symbol moves to the designated location associated with the setback condition, until the symbol moves to one of the locations that is not between the first location and the second location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);

- A processor operable to provide the player at least one award based on the number of designated locations the symbol is moved to before the symbol moves to one of the locations that is not between the first location and the second location (see at least 4:1-28);

- A triggering event associated with said primary game (see at least 3:59-67), wherein after the occurrence of said triggering event the symbol is moved from the first location to one of the designated locations along the path toward the second location (see at least 4:1-28), the symbol is relocated to one of the

designated locations along the path toward the first location and further from the second location if the symbol moves to the designated location associated with the setback condition (see at least 4:16-19), the symbol is moved to another one of the locations toward the second location and further from the first location wherein the movement of the symbol terminates if the symbol is moved to one of the locations that is not between the first location and the second location (see at least 1:65-2:14 and 4:29-58), and the player is provided an award based on the number of designated locations the symbol is moved to before the symbol moves to one of the locations that is not between the first location and the second location (see at least 4:1-28) (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof).

While Weiss teaches the invention substantially as described above, Weiss lacks in explicitly teaching the repetition *within the same play of a game* of the steps of (a) causing the symbol to move to at least one location along the path toward the first location (or along the path from a first to a second location) and (b) relocate the symbol to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition (or relocate the symbol to one of

the locations along the path toward the first location and further from the second

location) *until the symbol moves to the first location (or a location that is not between*

the first and second location).

In a related disclosure, Vancura describes landing on a setback location that

causes the player's symbol to move backward one or more spaces (see at least 7:22-

25). Additionally, Vancura teaches that certain squares may allow players to acquire

items that may later be exchanged for value (7:41-42). This teaching of Vancura

suggests that the player be awarded based not only upon the number of credits shown

on individual squares (such as shown in Fig. 7), but also awarding the player an

additional award based on the number of squares that the symbol ("movable indicia")

lands upon. This teaching is interpreted to be an award that is *separate from* the value

associated with the locations (e.g., a "WIN 50" in Fig. 7).

It would have been obvious to one of ordinary skill in the art at the time of

invention to modify Weiss to include the non-terminating setback condition of Vancura in

order to provide players a chance to continue playing the bonus game even though the

player's symbol has experienced a setback condition. One of ordinary skill in the art

would have recognized the benefit of allowing the player to continue playing the bonus

game even after experiencing a setback condition, in order to prevent the player from

becoming discouraged from continued wagering on the gaming device.

7.   Claims 53-54, 57-58, 61-62, 65-66, and 69-70 are rejected under 35 U.S.C.

103(a) as being unpatentable over Weiss in view of Vancura, and in further view of

Admitted Prior Art.

The combination of Weiss and Vancura teaches the invention substantially as

described above, but lacks in disclosing operating a game method through a data

network including the Internet. In a previous Official Action, the Examiner took Official

Notice that it was notoriously well known to those of ordinary skill in the art to operate

gaming machines through a data network including the Internet in order to control

gaming devices from a remote location. Applicant did not adequately challenge the

facts for which Official Notice was taken and therefore those facts are considered

Admitted Prior Art. See MPEP 2144.03. Thus, the above-mentioned claims are

obvious in view of the teachings of Weiss and Vancura. One of ordinary skill in the art

would have been motivated to modify the combination of Weiss and Vancura in order to

allow a player to control gaming devices from a remote location.

Response to Arguments

8.   Applicant's arguments with respect to the claims (see Remarks, pages 31-33)

have been considered but are moot in view of the new ground(s) of rejection under 35

USC §112.

9.   Applicant's arguments filed 8/4/2009 have been fully considered but they are not

persuasive.

The claimed invention as amended provides a player with an award based on the

determined number of locations the symbol has moved to before the symbol moves to a

first location. Applicant argues that this feature of the claimed invention is different from

that of the cited references. For instance, page 35 of the Remarks states:

> For example, in Vancura, if the movable indicia (interpreted by the Office Action
> as the symbol of independent Claim 1) lands on a predetermined square, the
> player accumulates a scoop of ice cream. In Vancura, the player may later
> exchange the accumulated scoops of ice cream for a value. Under this
> interpretation of Vancura, the player only accumulates a scoop of ice cream
> when the movable indicia lands on one of the predetermined squares associated
> with a scoop of ice cream. Thus, in Vancura, a movable indicia may land on a
> square other than a predetermined square associated with a scoop of ice cream,
> and no scoops of ice cream would be accumulated for the player. That is, in
> Vancura, each time the movable indicia moves to a location that is not a
> predetermined square associated with a scoop of ice cream, the number of
> scoops of ice cream accumulated does not increase. Hence, Vancura does not
> count each location visited by the movable indicia in the determination of the
> additional award based on the number of scoops of ice cream accumulated.

Applicant focuses only on instance of Vancura where the locations are not associated

with any indicia (such as ice cream scoops). However, Vancura allows for values to be

associated with all squares that would not serve to end the game. For instance, Figure

10 of Vancura shows that each square either rewards the player or ends the game. In

this case, the logic of Applicant's argument fails. See also 7:41-45 and 9:8-16 of

Vancura. Moreover, the accumulation of, e.g., ice cream scoops *requires* the

determination of a number of each of the locations that the symbol has moved to,

especially if there is one ice cream scoop per award square, contrary to Applicant's

arguments of pages 35-36 of the Remarks.

In view of the above explanations, the claimed invention fails to demonstrate

patentability over the cited prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
9/9/2009

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714